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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/868,515 06/18/01 SCHELBERGER

K 49651

EXAMINER

HM12/1024

KEIL & WEINKAUF  
1101 CONNECTICUT AVENUE N W  
WASHINGTON DC 20036

STILLER, K

ART UNIT

PAPER NUMBER

1617

DATE MAILED:

10/24/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

# Office Action Summary

Application No.

09/868,515

Applicant(s)

SCHELBERGER ET AL.

Examiner

Karl Stiller

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-10 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

This application is a 371 of PCT /EP99/09803, filed December 11, 1999.

#### ***Election/Restrictions***

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Morpholine or piperidine derivative compounds of Formula Ia, Ib, Ic, or Id, and individual benzamidoxime derivative compounds of Formula II useful in the method and composition herein.

Applicant is required, in reply to this action, to elect a single species which is a single morpholine or piperidine compound of Formula Ia, Ib, Ic, or Id and a single benzamidoxime derivative compound of Formula II to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The following claim(s) are generic: All claims are generic.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The morpholine or piperidine derivative compounds of Formula Ia, Ib, Ic, and Id are not of a similar nature. A common central core to the compounds is lacking, i.e., no common structural element is seen for the compounds of Formula Ia, Ib, Ic, and Id. Further, the benzamidoxime derivative compounds of Formula II are not of a similar nature. A common central core to the compounds is lacking, i.e. a significant structural element is not shared by the compounds. The only structural element shared by compounds of Formula II is a benzamidoxime moiety. The benzamidoxime may be substituted by the group ( $X^1$ ) which may be, for example, any C<sub>1</sub>-C<sub>4</sub>-haloalkyl, C<sub>1</sub>-C<sub>4</sub>-haloalkoxy, or halogen; the groups ( $X^2$  to  $X^5$ ) which may be, for example, independently any C<sub>1</sub>-C<sub>4</sub>-alkyl, C<sub>1</sub>-C<sub>4</sub>-haloalkyl, C<sub>1</sub>-C<sub>4</sub>-alkoxy, C<sub>1</sub>-C<sub>4</sub>-haloalkoxy, halogen, or hydrogen; the group ( $R^1$ ) which may be, for example, any C<sub>1</sub>-C<sub>4</sub>-alkyl, C<sub>2</sub>-C<sub>6</sub>-alkenyl, C<sub>2</sub>-C<sub>6</sub>-alkynyl, or C<sub>1</sub>-C<sub>4</sub>-alkyl- C<sub>3</sub>-C<sub>7</sub>-cycloalkyl, wherein each radical may carry substituents selected from C<sub>1</sub>-C<sub>4</sub>-alkoxy, cyano, or hydrogen; the group ( $R^2$ ) which may be, for example, any phenyl radical or 5 or 6 membered saturated or unsaturated heterocycle radical having at least one heteroatom selected from N, O, and S, where the cyclic radicals may have one to three substituents selected from C<sub>1</sub>-C<sub>4</sub>-alkyl, C<sub>1</sub>-C<sub>4</sub>-alkoxy, C<sub>1</sub>-C<sub>4</sub>-haloalkyl, C<sub>1</sub>-C<sub>4</sub>-haloalkoxy, C<sub>1</sub>-C<sub>4</sub>-alkoxy-C<sub>2</sub>-C<sub>4</sub>-alkenyl, C<sub>1</sub>-C<sub>4</sub>-alkoxy-C<sub>2</sub>-C<sub>4</sub>-alkynyl; the groups ( $R^3$  and  $R^4$ ) which

Art Unit: 1617

may be, for example, independently any C<sub>1</sub>-C<sub>4</sub>-alkyl, C<sub>1</sub>-C<sub>4</sub>-alkoxy, C<sub>1</sub>-C<sub>4</sub>-alkylthio, N-C<sub>1</sub>-C<sub>4</sub>-alkylamino, C<sub>1</sub>-C<sub>4</sub>-haloalkyl, C<sub>1</sub>-C<sub>4</sub>-haloalkoxy, or hydrogen.

A telephone call was made to Herbert Keil on October 12, 2001 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl Stiller whose telephone number is 703-306-3219. The examiner can normally be reached Monday through Friday, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached at 703-308-4612. The fax phone number for the organization where this application or proceeding is assigned is 703-308-4556 for regular communications.

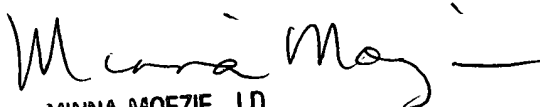
Application/Control Number: 09/868,515

Page 5

Art Unit: 1617

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Stiller: ks  
October 17, 2001

  
MINNA MOEZIE, J.D.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600